

REMARKS

Claims 1-39 are pending. Claims 1, 17, 26, and 34 have been amended. No new matter has been added.

Support for the claim amendments can be found at least on pages 9-10, ¶ [0033], ll. 9-13.

A decision may be made as to whether the data communication is likely to require more than a threshold amount of time (step 515). If the delay is likely to be short, it may be desirable not to present an advertisement, and the process 500 may wait for the next data communication request. If the delay is sufficiently long, however, it may be desirable to present an advertisement on the mobile device during the data communication.

Information Disclosure Statement

An information disclosure statement with accompanying form 1449 was filed March 14, 2006. Applicant respectfully requests the Examiner fully consider all references listed in the form 1449 and return a sign copy initialing all references considered.

35 U.S.C. § 102 Rejections

Claims 1-7, 17, 21-24, and 34-35 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Publication No. 2005/0131837 to Sanctis et al. ("Sanctis"). Claims 1, 17 and 34 have been amended to obviate the contentions.

Independent Claim 1

With respect to claim 1, Sanctis does not disclose each and every element of the claim. Claim 1 now recites ***determining a time required to complete the wireless communication; and presenting the stored advertisement on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time.***

In contrast, Sanctis is directed to sending to a mobile device a mobile alert message that the user must acknowledge and manually read in order to view a message related to the alert. See Sanctis, ¶¶ [0042]-[0044].

The mobile device 30 next determines at block 76 whether or not the user has entered a "Present Messages" input to invoke presentation of the mobile alert. If not, the process passes from block 76 to block 78....If, however, the mobile device 30

determines at block 76 that the user has entered a "Present Messages" input, the process passes to block 80." *Id.* at ¶ [0043].

"Block 80 illustrates the mobile device 30 presenting the mobile alert within the display 32 in accordance with the format of the mobile alert, and optionally, user preferences and/or the capabilities of the mobile device 30." *Id.* at ¶ [0044].

Thus in Sanctis, even if an advertisement is sent attached to the mobile alert message, the trigger that presents the advertisement to the user on the mobile device display is an action by the user to "Present Messages." *See* Sanctis at ¶ [0043]. Sanctis does not determined a required wireless communication time or compare this time to a threshold time in order to determine if the advertisement should be presented to the user. Therefore, Sanctis cannot reasonably interpreted to disclose ***determining a time required to complete the wireless communication; and presenting the stored advertisement on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time.***

For at least these reasons, claim 1 is patentable over Sanctis.

Independent Claims 17 and 34

With respect to claims 17 and 34, features similar to those recited in claim 1 are likewise recited. Thus, claims 17 and 34 are patentable over Sanctis for at least the reasons set forth with respect to claim 1 above.

Dependent Claims 2-7, 21-24, and 35

Claims 2-7, 21-24, and 35 depend from claims 1, 17, and 34, and thus are patentable over Sanctis or at lest the reasons set forth with respect to claims 1, 17, and 34 above. In addition, these dependent claims are patentable over Sanctis for independent reasons.

For example, with respect to claim 7, Sanctis fails to disclose ***presenting the advertisement on the mobile device comprises presenting the advertisement during a delay period, with the delay period representing a time during which the download of data occurs*** as recited in the claim. While the Examiner alleges that Sanctis discloses the features at ¶ [0114], the cited portion of Sanctis fails to disclose the features. In contrast, Sanctis discloses that "[u]pon receiving this message, the mobile device 30 prompts the user to view the message. **If the user chooses to do this**, then a BREW application is opened and the user can view more

detailed (e.g., graphical) information about the product..." (Emphasis added). *Id.* Thus, as set forth with respect to claim 1 above, the user must decide to view the advertisement. Further, Sanctis is silent as to presenting the advertisement during a delay as required in claim 7.

For at least this additional reason, claim 7 is patentable over Sanctis.

35 U.S.C. § 103 Rejections

Claims 8-16, 18-20, 25-28, 30-33, and 36-39 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over the combination of Sanctis and U.S. Patent Publication No. 2002/0166127 to Hamano et al. ("Hamano"). Claims 1, 17, 26, and 34 have been amended to obviate the contentions.

Dependent Claims 8-16

Claims 8-16 depend from claim 1, and thus are patentable over Sanctis for at least the reasons set forth with respect to claim 1 above. The addition of Hamano fails to alleviate the deficiencies of Sanctis.

For example, Hamano also fails to disclose ***determining a time required to complete the wireless communication; and presenting the stored advertisement on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time*** as recited in claim 1. In contrast, Hamano discloses that "the remote display terminal start up screen can be used to display advertising during a period of time while the terminal is 'booting up'." Hamano, ¶ [0023]. Thus, Hamano is restricted to displaying the advertisement during the "boot up" period only. In fact, Hamano is silent as to ***determining a time required to complete the wireless communication; and presenting the stored advertisement on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time*** as recited in claim 1.

For at least these reasons, the combination of Sanctis and Hamano fails to disclose each and every element of claim 1. Since claim 8 depends from claim 1, the combination of Sanctis and Hamano also fails to disclose each and every element of claim 7, and thus claim 7 is patentable over the proposed combination of Sanctis and Hamano for at least the reasons set forth with respect to claim 1 above.

In addition, these dependent claims are patentable over the proposed combination of Sanctis and Hamano for independent reasons.

For example, with respect to claim 8, the Examiner concedes that Sanctis fails to disclose ***determining that the stored advertisement has expired; and sending a notification of the expiration in response to the expiration determination.*** The addition of Hamano fails to alleviate the deficiencies of Sanctis.

While the Examiner alleges that Hamano discloses the features at FIG. 2; pg. 2, ¶ [0028]; and pg. 3, ¶ [0033], the cited portions of Hamano do not disclose the features. Indeed, Hamano only discloses determining if the advertisements are “sufficiently current.” *See* Hamano at ¶ [0028]. Advertisements that are “sufficiently current” does not necessarily mean the advertisements have expired. Hamano’s disclosure supports this argument. “For example, a local department store may be having a three-day sale and want to display advertisements for that sale only during the week prior to the sale.” *Id.* at ¶ [0033]. While the department store wants to advertise only during the week prior to sale, the advertisement has not expired until the day after the sale. Thus, in Hamano, how “current” the advertisement is relates only to determining if the advertisement should be displayed during the week prior to sale, and not necessarily that the advertisement has expired.

For at least this additional reason, claim 8 is patentable over the proposed combination of Sanctis and Hamano.

Claims 9-12 depends from claim 8 and 1, and thus are patentable for at least this additional reason set forth with respect to claim 8 above.

With respect to claim 14, the Examiner seems to admit that Sanctis fails to disclose that the ***advertisement comprises a bitmap*** as recited in the claim. Despite the Examiner’s allegation, the cited portions of Hamano (page 1, ¶ [0009]) fails to disclose that the ***advertisement comprises a bitmap***. While the Examiner contends that Hamano “obviously includes the ability to view bitmaps,” there is no support for the allegation in Hamano, and the Examiner fails to explain why Hamano obviously discloses the feature. Displaying “images” as disclosed in Hamano cannot reasonably be interpreted to include support for bitmaps since there are other image display formats such as JPEG and TIFF.

For at least this additional reason, claim 14 is patentable over the proposed combination of Sanctis and Hamano.

With respect to claim 15, the proposed combination of Sanctis and Hamano fails to disclose ***the bitmap comprises multiple frames, with presenting the advertisement on the mobile device comprising sequentially displaying the frames.*** As set forth with respect to claim 14 above, the combination of Sanctis and Hamano fails to disclose a bitmap. Further, Hamano fails to disclose whether the images displayed ***comprises multiple frames*** as required in claim 15. Since the images in Hamano can be single frame images, those images cannot reasonably be interpreted to include multiple frames without an express disclosure by Hamano.

For at least this additional reason, claim 15 is patentable over the proposed combination of Sanctis and Hamano.

Dependent Claims 18-20, and 25

Claims 18-20 and 25 depend from claim 17, and thus are patentable over Sanctis as set forth with respect to claim 17 above. In addition, as set forth with respect to claim 8 above, the addition of Hamano fails to disclose each and every element of claim 17. For example, Hamano fails to disclose ***determining a time required to complete the wireless communication; and presenting the stored advertisement on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time*** as recited in claim 17. Therefore, claims 18-20 and 25 are patentable over the combination of Sanctis and Hamano for at least failing to disclose each and every element of claim 17.

In addition, claims 18-20 and 25 are patentable over the proposed combination of Sanctis and Hamano for independent reasons.

For example, with respect to claim 25, the proposed combination of Sanctis and Hamano fails to disclose that ***the machine-readable medium further stores instructions for causing one or more processors to perform operations comprising maintaining statistical data relating to the advertisement*** as recited in the claim. While the Examiner cites to ¶ [0117] of Sanctis and ¶ [0065] of Hamano, the cited portions of Sanctis and Hamano fail to disclose the features. Indeed both Sanctis and Hamano are silent as to ***maintaining statistical data relating to the advertisement*** as recited in claim 25. Further, the Examiner alleges that the combination of

Sanctis and Hamano “obviously” discloses the features without providing logical reasoning or factual evidence in either references that supports the allegation. The Examiner also fails to provide the requisite motivation for the allegedly “obvious” combination. These assertions are legally improper and must be retracted.

For at least these additional reasons, claim 25 is patentable over the proposed combination of Sanctis and Hamano.

Independent Claim 26

Claim 26 recites similar features recited in claims 1, 17 and 34, and thus claim 26 is patentable over the combination of Sanctis and Hamano for at least the reasons set forth with respect to claims 1, 17 and 34 above. For example, the combination of Sanctis and Hamano fails to disclose that ***the advertising application on a mobile device presents the new advertisement during the delay if the delay is longer than a threshold time*** as required in claim 26.

Dependent Claims 27-28 and 30-33

Claims 27-28 and 30-33 depend from claim 26, and thus are patentable over the proposed combination of Sanctis and Hamano for at least the reasons set forth with respect to claim 26 above.

In addition, claims 27-28 and 30-33 are patentable over the proposed combination of Sanctis and Hamano for additional reasons.

For example, claims 27-28 recite ***tracking statistics*** relating to the advertisement, and as set forth with respect to claim 25, the combination of Sanctis and Hamano fails to disclose ***tracking statistics*** as required in claims 27-28.

Dependent Claims 36-39

Claims 36-39 depends from claim 34, and thus are patentable over Sanctis as set forth with respect to claim 34 above. As set forth with respect to claims 1, 17, and 26 above, the addition of Hamano fails to alleviate the deficiencies of Sanctis. For example, the combination of Sanctis and Hamano fails to disclose ***determining a time required to complete the wireless communication, the time representing a period of delay in the wireless communication session; and presenting one or more of the advertisements on the mobile device during the***

period of delay in the wireless communication session if the determined time is longer than a threshold time as required in claim 34.

Therefore, claims 36-39 are patentable over the combination of Sanctis and Hamano for at least failing to disclose each and every element of claim 34.

In addition, claims 36-39 are patentable over the combination of Sanctis and Hamano for additional independent reasons.

For example, with respect to claim 36, the Examiner concedes that Sanctis fails to disclose that ***the period of delay comprises a time during which a download of data occurs*** as required in the claim. Thus, claim 36 requires that the advertisement is presented to the user during the time a download of data occurs. While the Examiner alleges that Hamano discloses the feature at ¶ [0037] of Hamano, the cited portion of Hamano fails to disclose the feature. The delay disclosed in Hamano is the time during which a “boot up” occurs. This “boot up” delay time does not require downloading of data. Indeed, Hamano discloses that “there is a short delay while the programs are loading and executing before the user can interact on the internet.” Hamano, ¶ [0037]. Since the delay occurs before the user can interact on the internet, the delay period in Hamano cannot reasonably be interpreted as ***a time during which a download of data occurs***.

For at least this additional reason, claim 36 is patentable over the combination of Sanctis and Hamano.

Dependent Claim 29

Claim 29 stand rejected under 35 U.S.C. 103(a) as allegedly being obvious over the combination of Sanctis, Hamano and U.S. Patent Application Publication No. 2004/0003398 to Donian et al. (“Donian”).

Claim 29 depends from claim 26, and thus is patentable over the combination of Sanctis and Hamano for at least the reasons set forth with respect to claim 26 above. Similar to Sanctis and Hamano, Donian does not disclose that ***the advertising application on a mobile device presents the new advertisement during the delay if the delay is longer than a threshold time*** as required in claim 26. Indeed, Donian is directed to providing to consumers “the free and unlimited use of secure media content, by offering, a free general license for use of content with

paid commercial advertisements and other promotional material inserted into the content stream at certain intervals.” Donian, ¶ [0115]. Thus, the advertisement is displayed to the user anytime the user request viewing of the secure media content, and Donian does not compare the delay time to a threshold time as required in claim 26.

In addition, the Examiner concedes that the combination of Sanctis and Hamano fails to disclose ***assigning a number of presentations for the selected new advertisement; and transmit the assigned number to the mobile device*** as required in claim 29. The addition of Donian fails to alleviate the deficiencies of Sanctis and Hamano.

While the Examiner alleges that Donian discloses the features at ¶ [0147], the cited portion of Donian fails to disclose the features. Donian discloses that “[w]ith segmented media, the player/viewer holds a sense of particular ad blocks retaining their own sense of place in the sequence, with the ads chosen to go along with a pre-determined portion of the content.” Donian, ¶ [0147]. The segmented media with attached ads in Donian cannot reasonably be interpreted as ***assigning a number of presentations for the selected new advertisement; and transmitting the assigned number to the mobile device*** as required in claim 29. Donian is silent to the features and the Examiner fails to explain how the cited portions of Donian discloses the features.

For at least this additional reason, claim 29 is patentable over the combination of Sanctis, Hamano, and Donian.

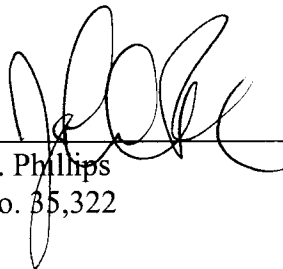
Conclusion

In view of the remarks and the claim amendments, all of the claims are in condition for allowance. A formal notice to that effect is respectfully requested.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Please apply \$225.00 for a two-month extension of time fee, and any additional charges or credits to deposit account 06-1050.

Respectfully submitted,



John C. Phillips
Reg. No. 35,322

Date: June 13, 2006

PTO Customer No. 20985
Fish & Richardson P.C.
12390 El Camino Real
San Diego, California 92130
Telephone: (858) 678-5070
Facsimile: (858) 678-5099